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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,039

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Philipp Stoessel

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EXAMINER

AULAKH, CHARANJIT

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

03/04/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,039	Applicant(s) STOESSEL ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-17,19,20,22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-17,19,22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/10, 12/6/10</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. According to paper filed on March 18, 2010, the applicants have filed a RCE. The applicants have also canceled claims 5 and 18 and furthermore, have amended claims 1, 29 and 30.
2. Claims 1-4, 6-17, 19, 20, 22 and 24-30 are pending in the application. Claim 20 remains withdrawn as being directed to non-elected invention.

Information Disclosure Statement

3. In the IDS submitted on 3/18/10, some references were not considered and were lined through since these references were not present in the application and furthermore, the year of publication was missing in all these references.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4, 6-17, 19, 22 and 24-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In independent claims 1, 29, 30 as well as in claims 6-8 and 19, there is no written description for preparing

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compounds where plurality of substituents R define mono- or polycyclic, aliphatic or aromatic ring systems. There is not even a single example present for preparing such compounds.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-4, 6-17, 19, 22 and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 1, 29, 30 as well as in claims 6-8 and 19, for the value of variable R, the term ----- a plurality of substituents R may in turn define a further mono- or polycyclic, aliphatic or aromatic ring system ----- is indefinite since these specific rings including size of the rings, number and types of heteroatoms present are not defined.

In independent claims 1, 29 and 30, the values of variables Cy1 and Cy2 defined as ---- homo- or heterocyclic ring ---- are indefinite since the number of carbon atoms and/or heteroatoms present in these rings are not defined.

Claim 4 recites the limitation "contains 1 to 6 atoms or is a 3- to 6-membered homo- or heterocyclic ring for the value of variable V" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation " (Y)_c attached to M or metal" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation " (Y)_c attached to M or metal" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

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Claim 8 recites the limitation " (Y)c attached to M or metal" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 1-4, 6-17, 19, 22 and 24-30 are objected for containing non-elected subject matter.

9. It is of note that compounds directed to the elected subject matter are already patented in US patents 7,569,692, 7,442,797 and 7,732,606 (see claims). Although these patents do not constitute prior art under 35 U.S.C. 102(e) yet the instant compounds can not be allowed without declaring an interference with these issued patents, once the instant compounds are found allowable.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charanjit S. Aulakh/
Primary Examiner, Art Unit 1625